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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/561,260
Filing Date: October 16, 2006
Appellant: COLGRAVE, JOHN

Steven L. Nichols (Reg. No. 40,326)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02 December 2010 ("2010 Brief") appealing from the

Office Action mailed 04 August 2010.

(1) Real Party in Interest

The Examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the 2010 Brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

17-30.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The Examiner has no comment on the summary of claimed subject matter contained in the 2010 Brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The Examiner has no comment on the Appellant's statement of the grounds of rejection

to be reviewed on appeal. Every ground of rejection set forth in the Office Action from which

the appeal is taken (as modified by any advisory actions) is being maintained by the Examiner

except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW

GROUNDS OF REJECTION."

(7) Claims Appendix

The Examiner has no comment on the copy of the appealed claims contained in the

Appendix to the 2010 Brief.

(8) Evidence Relied Upon

5,414,852 A	Kramer et al.	05-1995
5,629,980 A	Stefik et al.	05-1997
2002/0046157 A1	Solomon	04-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112, ¶1

Claims 21-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 21 recites "the registry comprising: at least one processor." Applicants have only disclosed that "client/server 10 has a processor 101" (Specification, Page 5, Line 27). The recitation of "at least one processor" covers registries with two processors or more. Because Applicants did not disclose multiple processors in their original disclosure, the limitation "at least one processor," which claims registries with more than one processor, is new matter.

Furthermore, Applicants disclose that it is the client/server 10 that has the processor. Applicants also disclose "a UDDI registry may be installed on any such client/server" (Specification, Page 5, lines 23-24). Because the registry is installed on the client/server it cannot be the client/server. Because the registry is not the client/server and because Applicant's have only disclosed that the "client/server 10 has a processor 101," a registry with a processor is not necessarily present in the original disclosure. Because a registry with a processor is not necessarily present in the original disclosure, it is new matter.

Similarly, Applicants disclose "client/server has…a RAM volatile memory element 102, a non-volatile memory 103" (Specification, Page 5, Lines 27-29). Again, the memory elements are disclosed as part of the client/server. Because the registry is installed on the client/server it

cannot be the client/server, as noted in the preceding paragraph. Because the registry is not the

client/server and because Applicant's have only disclosed that the "client/server 10 …a RAM

volatile memory element 102, a non-volatile memory 103," a registry with a memory is not

necessarily present in the original disclosure. Because a registry with a memory is not

necessarily present in the original disclosure, it is new matter.

       Claims 21-26 are rejected under 35 U.S.C. § 112, ¶1 (scope of enablement). Applicants

recite "said processor is configured to: receive…details associated therewith." In claim 21, the

Examiner finds that the "processor" is modified by the purely functional limitation "configured

to: receive…details associated therewith." Because the processor is modified by pure functional

language with no limitation of structure, Applicants are claiming _all_ structures (_i.e._, _all_ processor

configurations) for performing the claimed function. Because Applicants are claiming _all_

structures (_i.e._, _all_ processor configurations) for performing the claimed function and because the

original specification does not enable _all_ structures (_i.e._, _all_ processor configurations) for

performing the claimed function, claim 21 is rejected under 35 U.S.C. § 112, ¶1 (scope of

enablement). See _Ex parte Miyazaki_, 89 USPQ2d 1207, 1215-17 (B.P.A.I. 2008)(precedential)

       The language of claim 21 has been amended so it no longer invokes interpretation under

35 U.S.C. 112, ¶6 because it no longer recites "means for." Because it does not invoke

interpretation under 35 U.S.C. 112, ¶6, it would not be proper to import structure from the

Specification into the claim. See MPEP § 2106 II.(C).

       Applicants have enabled only a software configuration in their original disclosure

(Specification, Page 12, Lines 24-33). However, the claim is not limited to only a software

configuration. The claim also encompasses a hardware configuration for performing the receiving step. Because the claim encompasses both subject matter that is enabled and subject matter that is not enabled in the disclosure, claim 21 is rejected under 35 U.S.C. § 112, ¶1. See MPEP § 706.03.

Claim Rejections - 35 USC § 112, ¶2

Claims 17-30 are rejected under 35 U.S.C. 112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites "receiving a request in a processor associated with said registry from a user to access a business entity definition comprising a plurality of information elements, each of said information elements having permission details associated therewith" which renders the claim indefinite. One of ordinary skill in the art would not understand what the "permission details" are associated with. Do the information elements have permission details and the permission details are associated with the request? Are the permission details associated with the processor? Because one of ordinary skill in the art would not understand what the permission details are associated with, the claim is indefinite because the metes and bounds of the claim cannot be ascertained by one of ordinary skill in the art.

Also, one of ordinary skill in the art would not understand if it is the request or the business entity definition that is "comprising a plurality of information elements." Again this prevents one of ordinary skill in the art from ascertaining the metes and bounds of the claim.

Claims 21 and 27 contain similar limitations and are rejected under the same rationales.

In claims 17-30, the phrase "business entity definition" is indefinite because–to one of ordinary skill in this art–the metes and bounds of the phrase can not be reasonably determined. First, the Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner's position that the phrase "business entity definition" (as used in the context of these particular claims) is not known to those of ordinary skill in this art. However, if Applicant believes that the phrase *is* old and well known in the art, Applicant should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art and provide appropriate evidence in support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicant's express statement that the phrase is old and well known in the art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112, ¶2 rejection.

Claim 21 recites "[a] registry of business entity definitions, the registry comprising: at least one processor; and a computer readable memory." As noted in the previous Office Action, Appellant was given actual notice that one of ordinary skill in the art would recognize a "registry of business entity definitions" as an arrangement of data (Paper – 20100203, Paragraph 54). Applicants have not argued this assertion. However, Applicants have added physical components (processor and memory) to the arrangement of data. Claim 21 is indefinite because

one of ordinary skill in this art would not understand how a data structure (*i.e.*, a registry) can

comprise physical components.

In claim 25, the phrase "business service entity information element" is indefinite

because–to one of ordinary skill in this art–the metes and bounds of the phrase can not be

reasonably determined. First, the Examiner has carefully reviewed the original specification and

can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the

Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03.

Based upon this review and the review of the original specification, it is the Examiner's position

that the phrase "business entity definition" (as used in the context of this particular claim) is not

known to those of ordinary skill in this art. However, if Applicant believes that the phrase *is* old

and well known in the art, Applicant should (in their next appropriately filed response) expressly

state on the record that the phrase is old and well known in the art and provide appropriate

evidence in support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicant's express

statement that the phrase is old and well known in the art and (2) sufficient evidence in support

thereof, the Examiner will withdraw this particular 35 U.S.C. §112, ¶2.

In claims 25, the phrase "binding template information element" is indefinite because–to

one of ordinary skill in this art–the metes and bounds of the phrase can not be reasonably

determined. First, the Examiner has carefully reviewed the original specification and can not

locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has

again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this

review and the review of the original specification, it is the Examiner's position that the phrase

"business entity definition" (as used in the context of this particular claim) is not known to those

of ordinary skill in this art. However, if Applicant believes that the phrase *is* old and well known

in the art, Applicant should (in their next appropriately filed response) expressly state on the

record that the phrase is old and well known in the art and provide appropriate evidence in

support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicant's express statement that the

phrase is old and well known in the art and (2) sufficient evidence in support thereof, the

Examiner will withdraw this particular 35 U.S.C. §112, ¶2.

In claims 25, the phrase "technical model information element" is indefinite because–to

one of ordinary skill in this art–the metes and bounds of the phrase can not be reasonably

determined. First, the Examiner has carefully reviewed the original specification and can not

locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has

again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this

review and the review of the original specification, it is the Examiner's position that the phrase

"business entity definition" (as used in the context of this particular claim) is not known to those

of ordinary skill in this art. However, if Applicant believes that the phrase *is* old and well known

in the art, Applicant should (in their next appropriately filed response) expressly state on the

record that the phrase is old and well known in the art and provide appropriate evidence in

support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicant's express statement that the

phrase is old and well known in the art and (2) sufficient evidence in support thereof, the

Examiner will withdraw this particular 35 U.S.C. §112, ¶2.

In claim 25, the phrase "business entity information element" is indefinite because–to one of ordinary skill in this art–the metes and bounds of the phrase can not be reasonably determined. First, the Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner's position that the phrase "business entity definition" (as used in the context of this particular claim) is not known to those of ordinary skill in this art. However, if Applicant believes that the phrase *is* old and well known in the art, Applicant should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art and provide appropriate evidence in support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicant's express statement that the phrase is old and well known in the art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112, ¶2.

The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, ¶2, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) ("Because the claims are indefinite, the claims, by definition, cannot be construed."). However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

Claim Rejections - 35 USC § 102

Claims 17, 21, and 27, as understood by the Examiner, are rejected under 35 U.S.C. §

102(b) as being anticipated by Kramer (US 5,414,852).

As to claims 17, 21, and 27, Kramer shows:

A method for a registry of business entity definitions to handle user requests to

access business entity definitions, the method comprising:

receiving a request in a processor (inherent to the computer because a computer

needs a processor the execute anything, Title) associated with said registry (the data is stored on

the computer, Title) from a user ("a user requesting access at one end," C 3, LL 50-51) to access

a business entity definition ("data object," C 3, L 36) comprising a plurality of information

elements ("identifier of the original invoking user and the calling data managers," C 4, LL 66-

68), each of said information elements having permission details associated therewith ("A match

must be found…in order for access to be allowed by the system level interface." C 5, LL 1-2);

obtaining the identity of the user from data associated with the request with said

processor ("user identifier to identify an invoking user" with the invoking being the result of the

request, Claim 1);

determining with said processor, for each of said information elements, whether

the user has permission to access that said information element (Figure 4) based on the

permission details associated with that said information element ("Does user have permission for

this type of access?" Step 68) and said identity of the user ("Is user on access list?" Step 64);

and

> with said processor, denying the user access to those elements (Step 66) for which

it is determined that the user does not have permission (if the answer to steps 64 or 68 are no,

Figure 4).

Claim Rejections - 35 USC § 103

Claims 19, 20, 23, 24, 29, and 30, as understood by the Examiner, are rejected under 35

U.S.C. 103(a) as being unpatentable over Kramer in view of Stefik (US 5,692,980).

Kramer teaches as set forth above in regards to claims 17, 21, and 27, but does not

expressly show:

> determining with said processor whether the user has permission to access

information in the business entity definition from permission details associated with the business

entity definition and the identity of the user comprises determining with said processor whether a

user has permission to access an information element from an access policy and permission

details associated with a different information element; and

> the information elements are in a hierarchy and wherein determining with said

processor whether the user has permission to access information in the business entity definition

from permission details associated with the business entity definition and the identity of the user

comprises determining with said processor that a user does not have permission to access a first

information element if permission details associated with one or more second information

elements directly beneath the first information element in the hierarchy indicate that user does

not have access to one or more of the second information elements.

      However, Stefik shows a root d-block **1101** corresponding to the business entity

definition and child d-blocks **1102-1104** and **1105** corresponding to information elements. The

root/child relationship is hierarchical. The root and each of the child d-blocks contains a separate

"rights portion" (Figure 11). The root d-block **1101** gives the user access ("view") rights so the

user can see that the child d-blocks **1102-1104** and **1105** exist. For each of the d-blocks **1102-**

1103 and **1105** the user is shown to currently have an access ("view") right. For d-block **1104**

the user does not currently have access because a fee is required.

      Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to have modified the teachings of Kramer to include the hierarchical structure of

elements with separate permissions because it allows the creator of the elements a more granular

control of the elements which in turn allows for additional revenue generation from charging a

fee for access to particular data.

      Claims 18, 22, 25, 26, and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over

Kramer in view of Solomon (US 2002/0046157).

      Kramer teaches as set forth above in regards to claims 17, 21, and 27, but does not

expressly show:

           the request specifies a search criteria, and wherein the method further comprises:

determining with said processor what information in the business entity definition the user

wishes to access using the search criteria to locate the business entity definition; and

determining with said processor whether the user has permission to access the information that

the user wishes to access;

the registry is a UDDI registry and the information in the business entity

definition is a business entity information element, the business entity information element

containing one or more business service entity information elements, each business service entity

containing one or more binding template information elements and each binding template

containing one or more references each referring to a technical model information element.

However, Solomon shows the conducting of searches being facilitated by a UDDI

registry [0028].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to have modified the teachings of Kramer to store the data in a UDDI in order to

facilitate searching to allow the requestor to more easily find the desired information.

Claims 17, 21, and 27, as understood by the Examiner, are _alternatively_ rejected under 35

U.S.C. 103(a) as being unpatentable over Kramer in view of Stefik.

It is the Examiner's principle position that these claims are anticipated by Kramer as set

forth above. The Examiner's position is that because a computer needs a processor to execute

anything, a processor is inherent in the computer of Kramer. However, in case a reviewing body

disagrees with this inherent teaching of Kramer, the Examiner provides the following alternative

rejections.

As to claims 17, 21, and 27, Kramer shows:

A method for a registry of business entity definitions to handle user requests to access business entity definitions, the method comprising:

receiving a request from a user ("a user requesting access at one end," C 3, LL 50-51) to access a business entity definition ("data object," C 3, L 36) comprising a plurality of information elements ("identifier of the original invoking user and the calling data managers," C 4, LL 66-68), each of said information elements having permission details associated therewith ("A match must be found…in order for access to be allowed by the system level interface." C 5, LL 1-2);

obtaining the identity of the user from data associated with the request ("user identifier to identify an invoking user" with the invoking being the result of the request, Claim 1);

determining, for each of said information elements, whether the user has permission to access that said information element (Figure 4) based on the permission details associated with that said information element ("Does user have permission for this type of access?" Step 68) and said identity of the user ("Is user on access list?" Step 64); and

denying the user access to those elements (Step 66) for which it is determined that the user does not have permission (if the answer to steps 64 or 68 are no, Figure 4).

Kramer does not expressly disclose the performance of the recited steps by a processor.

However, Stefik shows a processor 1201 which is used to execute the software necessary to manage usage rights (C 14, LL 7-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Kramer to add a processor for executing the recited method steps because a processor is needed to have the computer of Kramer work.

Examiner's Findings of Fact ("EFF")

EFF-1: Based upon a review of the original disclosure and the 2010 Brief, the Examiner finds that a "registry comprising: at least one processor" is not expressly disclosed.

EFF-2: Based upon a review of the original disclosure and the 2010 Brief, the Examiner finds that a "registry comprising: at least one processor" is not inherently disclosed because Appellant has not shown that a "registry comprising: at least one processor" is necessarily present in the original disclosure.

EFF-3: Based upon a review of the original disclosure and the 2010 Brief, the Examiner finds that a "registry comprising... a computer readable memory" is not expressly disclosed.

EFF-4: Based upon a review of the original disclosure and the 2010 Brief, the Examiner finds that a "registry comprising... a computer readable memory" is not inherently disclosed because Appellant has not shown that a "registry comprising... a computer readable memory" is necessarily present in the original disclosure.

(10) Response to Argument

Arguments which Appellant could have made but chose not to make in the 2010 Brief have not been considered by the Examiner and are deemed to be waived. See 37 C.F.R. §

41.37(c)(1)(vii). Moreover, Appellant is given actual notice that any additional arguments that

are raised for the first time in the Reply Brief are waived. See *Optivus Tech., Inc. v. Ion Beam*

Applications S.A., 469 F.3d 978, 989, 80 USPQ2d 1839, 1847-48 (Fed. Cir. 2006) ("[A]n issue

not raised by an appellant in its opening brief … is waived." (citation omitted) (internal quotation

marks omitted)); *Ex parte Borden IV*, No. 2008-004312, slip op. (BPAI January 7, 2010)

(informative)[1]; and *Ex parte Scholl*, No. 2007-3653, slip op. at 18-19 & n.13 (BPAI Mar. 13,

2008) (informative)[2].

I. *Arguments Regarding 35 U.S.C. §112, ¶1 (written description)*

A. *The Claimed "at least one processor" of Claim 21 is New Matter*

Appellant argues "the claimed term 'at least one processor' does not require multiple

processors, as the Examiner asserts." 2010 Brief at p. 11.

The Examiner agrees with Appellant in the sense that the <u>prior art</u> need not have multiple

processors to read on the claimed "at least on processor."   Likewise, upon the theoretical

issuance of this application, the Examiner agrees with Appellant in the sense that a <u>potential</u>

<u>infringer</u> of claim 21 need not have possession of multiple processors to infringe on Appellant's

invention.

Nevertheless, because the limitation "at least one processor" is alternative language that

can mean 'one processor' <u>or</u> 'two processors' <u>or</u> 'three processors,' etc., the Appellant's

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[1] Available at http://www.uspto.gov/ip/boards/bpai/decisions/inform/fd08004312.pdf

[2] Available at http://www.uspto.gov/web/offices/dcom/bpai/its/fd073653.pdf

specification does have to disclose all of these claimed alternatives (*e.g.*, the claimed 'one processor' <u>or</u> the claimed 'two processors' <u>or</u> the claimed 'three processors,' etc.) to have 112, ¶1 support for the "at least one processor." Appellant's specification must show possession of the alternative numbers of processors now recited in the claim by the "at least one processor" language.

Moreover, Appellant argues "A registry with only a single processor is a registry with 'at least one processor.' (Claim 21). As such, Appellant's specification and drawings clearly teach a registry system with 'at least one processor.' 2010 Brief at p. 11.

Basically, Appellant is arguing that because his specification has "[a] registry with only a single processor," then his specification shows possession of 'a registry with at least one processor.' The Examiner respectfully disagrees.

Indisputably, the phrase 'only a single processor' is <u>not</u> equivalent to the phrase "at least one processor." <u>The latter is much broader.</u> The latter limitation "at least one processor" is alternative language that can mean 'one processor' <u>or</u> 'two processors' <u>or</u> 'three processors,' etc. This is <u>much broader</u> than 'only a single processor.' Because Appellant's specification only supports a single processor, Appellant's specification does not have support for the <u>broader</u> "at least one processor." By claiming "at least one processor," Appellant is claiming embodiments that are broader than those supported by the specification. Accordingly, the "at least one processor" language is new matter.

B. *The Claimed "registry comprising: at least one processor" is New Matter*

Based upon a review of the original disclosure and the 2010 Brief, the Examiner found

that a "registry comprising: a processor" is not expressly disclosed. See EFF-1.

Based upon a review of the original disclosure and the 2010 Brief, the Examiner found

that a "registry comprising: a processor" is not inherently disclosed because Appellant has not

shown that a "registry comprising: a processor" is necessarily present in the original disclosure.

See EFF-2.

So in order to comply with 112, ¶1 (written description), and because the Examiner found

that the limitations in question are not expressly disclosed, the limitations must be inherently

disclosed. As a matter of law, in order for the limitations at issue to be inherently disclosed, the

limitations must be necessarily present in the original disclosure. See MPEP §2163 II A. 3. (b).

Appellant argues:

> Appellant's specification describes the UDDI registry as an active
> component that performs certain functionality. (See, e.g., Appellant's
> specification, p. 10 line 32 to p. 11 line 13). This functionality cannot be
> performed by merely software alone, as software is merely a set of instructions.
> Rather, the functions of the UDDI registry must inherently be performed by a
> machine executing software. Thus, the UDDI registry described in Appellant's
> specification inherently has a machine component. Taken in context with this fact,
> the specification's statement that "a UDDI registry may be installed on any such
> client/server" plainly teaches that the described client/server provides the essential
> hardware component to implement UDDI registry functionality. (Appellant's
> specification, p. 5 lines 23-24). As such, the specification plainly teaches a UDDI
> registry that "comprises" a processor.

2010 Brief at p. 13.

The Examiner respectfully disagrees. Even if, for the sake of argument, Appellant's

following statement is true, "the functions of the UDDI registry must inherently be performed by

a machine executing software," it does not *necessarily* follow that the UDDI registry comprises

"at least one processor," as recited in claim 21. As noted by Appellant above, the UDDI registry

is installed on a client/server, and it is the client/server that "provides the essential hardware

component to implement UDDI registry functionality." Therefore, it is within the scope of

Appellant's disclosure for a client/server to comprise the essential hardware (*i.e.*, a processor),

not the registry. Because a client/server can comprise the essential hardware (*i.e.*, a processor)

for implementing the registry, it is not inherent for the registry to comprise the processor, let

alone more than one processor.

Therefore, because Appellant's disclosure does not inherently or expressly disclose the

"registry comprising: at least one processor," the recitation of claim 21 "…the registry

comprising: at least one processor" is new matter.

Moreover, with particular respect to Appellant's "[a]s such, the specification plainly

teaches a UDDI registry that 'comprises' a processor." *Id*. Assuming, *arguendo*, this is true, 35

U.S.C. § 112, ¶1 (written description) requires disclosure, not what is obvious in view of the

disclosure (*i.e.*, not what is taught by the disclosure). "Entitlement to a filing date does not

extend to subject matter which is not disclosed, but would be obvious over what is expressly

disclosed. It extends only to that which is disclosed." *In re Huston*, 308 F.3d 1267, 1277, 64

USPQ2d 1801, 1807 (Fed. Cir. 2002) citing *Lockwood v. Am. Airlines Inc.*, 107 F.3d 1565, 1571-

72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

Again, limitations are either expressly disclosed or inherently disclosed. While Appellant

may feel that the disclosure teaches a UDDI registry that comprises a processor, such a registry

is neither inherently disclosed nor expressly disclosed.

C. *The Claimed "registry comprising… a computer readable memory" of Claim 21 is New Matter*

Based upon a review of the original disclosure and the 2010 Brief, the Examiner found that a "registry comprising… a computer readable memory" is not expressly disclosed. See EFF-3.

Based upon a review of the original disclosure and the 2010 Brief, the Examiner found that a "registry comprising… a computer readable memory" is not inherently disclosed because Appellant has not shown that a "registry comprising… a computer readable memory" is necessarily present in the original disclosure. See EFF-4.

So in order to comply with 112, ¶1 (written description), and because the Examiner found that the limitations in question are not expressly disclosed, the limitations must be inherently disclosed. As a matter of law, in order for the limitations at issue to be inherently disclosed, the limitations must be necessarily present in the original disclosure. See MPEP §2163 II A. 3. (b).

Appellant argues:

> Again, Appellant's specification describes the UDDI registry as an active component that performs certain functionality. (See, e.g., Appellant's specification, p. 10 line 32 to p. 11 line 13). This functionality cannot be performed by merely software alone, as software is merely a set of instructions. Rather, the functions of the UDDI registry must inherently be performed by a machine executing software from a computer-readable memory. Thus, the UDDI registry described in Appellant's specification inherently has a machine component. Taken in context with this fact, the specification's statement that "a UDDI registry may be installed on any such client/server" plainly teaches that the described client/server provides the essential hardware components to implement UDDI registry functionality. (Appellant's specification, p. 5 lines 23-24). Among the hardware described in the client/server of Appellant's specification are "a RAM volatile memory element" and a "non-volatile memory." (Appellant's specification, p. 5 lines 27-29, Fig. 1; see also p. 12 lines 24-33). As such, the

> specification plainly teaches a UDDI registry that "comprises" a computer
> readable memory.

2010 Brief at p. 14.

The Examiner respectfully disagrees. Even if, for the sake of argument, Appellant's

following statement is true, "the functions of the UDDI registry must inherently be performed by

a machine executing software from a computer-readable memory," it does not _necessarily_ follow

that the UDDI registry comprises "computer readable memory," as recited in claim 21. As noted

by Appellant above, the UDDI registry is installed on a client/server, and it is the client/server

that "provides the essential hardware component to implement UDDI registry functionality."

Therefore, it is within the scope of Appellant's disclosure for a client/server to comprise the

essential hardware (_i.e._, a computer readable memory, such as the "non-volatile memory" noted

by Appellant above), not the registry. Because a client/server can comprise the essential

hardware (_i.e._, a computer readable memory) for implementing the registry, it is not inherent for

the registry to comprise the computer readable memory.

Therefore, because Appellant's disclosure does not inherently or expressly disclose the

"registry comprising… a computer readable memory," the recitation of claim 21 "…the registry

comprising… a computer readable memory" is new matter.

Moreover, with particular respect to Appellant's "[a]s such, the specification plainly

teaches a UDDI registry that 'comprises' a computer readable memory." _Id_. Assuming,

arguendo, this is true, 35 U.S.C. § 112, ¶1 (written description) requires disclosure, not what is

obvious in view of the disclosure (_i.e._, not what is taught by the disclosure). "Entitlement to a

filing date does not extend to subject matter which is not disclosed, but would be obvious over

what is expressly disclosed. It extends only to that which is disclosed." *In re Huston*, 308 F.3d

1267, 1277, 64 USPQ2d 1801, 1807 (Fed. Cir. 2002) citing *Lockwood v. Am. Airlines Inc.*, 107

F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

 Again, limitations are either expressly disclosed or inherently disclosed. While Appellant

may feel that the disclosure <u>teaches</u> a UDDI registry that comprises a computer readable

memory, such a registry is neither inherently disclosed nor expressly disclosed.

 II. *<u>Arguments Regarding 35 U.S.C. §112, ¶1 (scope of enablement)</u>*

  A. *The Claimed "processor ... configured to [functions]"Is Not Enabled For*

<u>All</u> Processor Configurations

 Appellant argues:

> Claim 21 explicitly recites that a processor, an inherently structural
> element, performs all of the functionality described in claim 21. The processor
> performs this functionality as exemplified in Appellant's specification at, for
> example, p. 10 line 28 to p. 13 line 7, and Figs. 4-6. Thus, unlike the patent
> application in the *Miyazaki* cased cited by the Examiner, claim 21 does not recite
> any "purely functional claim element." (*See Miyazaki*, 89 USPQ2d at 1215-1217;
> Action, pp. 3- 4).

 2010 Brief at pp. 15-16.

 The Examiner respectfully disagrees. Even though the claim does recite the word

"processor," the claim also recites "configured to... [functions]" describing the processor in a

purely functional manner, which effectively results in Appellant claiming <u>all</u> processor

configurations for performing the claimed functions. The claim does not limit the structure (*i.e.*,

the configuration) of the processor to a particular structure other than a general purpose

processor. It is well known that a configuration can refer to a hardware configuration or a software configuration.[3] As discussed above, Appellant argues that the processor is the necessary <u>hardware</u> only for implementing the functions of the registry (the registry being the software). The specification does <u>not</u> enable a processor with a software configuration for performing the claimed functions (*i.e.*, a processor programmed with the registry). Therefore, Appellant's specification does not support the inclusion of software in the configuration of the processor itself. However, the claim limitation "processor… configured to [function]" encompasses both a hardware configuration of the processor and a software configuration of the processor (*i.e.*, all processor configurations for performing the claimed functions). Because Appellant is claiming configurations encompassing both hardware and software, and because admittedly Appellant's specification only supports a processor with a hardware configuration, claim 21 is rejected under §112, ¶1 (scope of enablement). See also MPEP §2164.08.

III. *Arguments Regarding 35 U.S.C. §112, ¶2*

   A. *The "permission details associated therewith" is Indefinite*

   Because Appellant only addresses specific claim language from claim 17, the Examiner will also only address the claim language of claim 17. Therefore, the patentability of claims 21 and 27 stand or fall with claim 17.

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[3] See <u>IEEE 100 The Authoritative Dictionary of IEEE Standards Terms</u>, 7th Edition, IEEE, Inc., New York, NY, Dec. 2000, defining *configuration* as "(1) (C) The physical and logical elements of an information processing system, the manner in which they are organized and connected, or both. Note: May refer to hardware configuration or software configuration."

Claim 17 recites "receiving a request in a processor associated with said registry from a user to access a business entity definition comprising a plurality of information elements, each of said information elements having permission details associated therewith."

According to The American Heritage® Dictionary of the English Language[4], the term

therewith can be interpreted as "With that, this, or it." The Examiner hereby adopts this definition under the broadest reasonable interpretation standard. In accordance with *In re Morris,* 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to this source to support his interpretation of the claims. Additionally, this definition is only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.

Accordingly, claim 17 can be interpreted as "receiving a request in a processor associated with said registry from a user to access a business entity definition comprising a plurality of information elements, each of said information elements having permission details associated [with that]." However, it is unclear what the "with that" is in reference to. In other words, the "with that" (*i.e.*, therewith) may refer to the "processor," the "registry," the "user," or the "definition."

Moreover, Appellant argues:

> Furthermore, the independent claims further indicate that the permission details associated with each information element indicate whether a given user has permission to access that information element. (Claims 17, 21, 27) (e.g., "determining... whether the user has permission to access that said information

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[4] See The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000.

>element based on the permission details associated with that said information
>element and said identity of the user.").

2010 Brief at p. 18.

The Examiner respectfully disagrees. Because one of ordinary skill cannot determine to

what the "permission details associated therewith" is in reference to (see analysis above), the

recitation of "the permission details associated with that said information element" is also

indefinite because it lacks proper antecedent basis in the claim. If Appellant desires the specific

interpretation discussed on p. 18 of the 2010 Brief, Appellant should amend the claim to

precisely limit the claim to such interpretation.

Moreover, Appellant argues:

>The specification describes the use of permission details in this context.
>(See e.g., Appellant's specification, p. 3 line 25 to p. 4 line 16, p. 8 line 6 to p. 9
>line 32, p. 10 line 1 to p. 10 line 25, Figs. 4-6).

2010 Brief at p. 18.

First, it is improper for the Examiner to import limitations from the specification. See

MPEP §2111.01 II.

Second, when a claim supports multiple interpretations, and Appellant's desired

interpretation is supported by the specification, Appellant should amend the claim to precisely

limit the claim to Appellant's desired interpretation. See *In re Wiggins*, 488 F.2d 538, 179

USPQ 421, 424 (CCPA 1973) (emphasis in original)(affirming 112, ¶2 rejection) ("[T]he

examiner, in his answer, indicated that appellants had support in the specification for a claim of

the same scope that appellants would now have us give claims 1 and 10. Therefore, we do not

think it would have been difficult to employ language in the claims precisely limiting them to

that scope.").

B. *The "receiving a request … comprising a plurality of information elements" is Indefinite*

Because Appellant only addresses specific claim language from claim 17, the Examiner

will also only address the claim language of claim 17. Therefore, the patentability of claims 21

and 27 stand or fall with claim 17.

Claim 17 recites "receiving a request in a processor associated with said registry from a

user to access a business entity definition comprising a plurality of information elements, each of

said information elements having permission details associated therewith."

This recitation is indefinite because it is unclear whether the "comprising a plurality of

information elements" refers to the "request," the "processor," the "said registry," or the

"business entity definition."

Appellant argues:

> The specification describes business entity definitions which include a
> plurality of information elements, but does not describe a request that includes a
> plurality of information elements.

2010 Brief at p. 19.

First, it is improper for the Examiner to import limitations from the specification. See

MPEP §2111.01 II.

Second, when a claim supports multiple interpretations, and Appellant's desired

interpretation is supported by the specification, Appellant should amend the claim to precisely

limit the claim to Appellant's desired interpretation. See *In re Wiggins*, 488 F.2d 538, 179

USPQ 421, 424 (CCPA 1973) (emphasis in original)(affirming 112, ¶2 rejection) ("[T]he

examiner, in his answer, indicated that appellants had support in the specification for a claim of

the same scope that appellants would now have us give claims 1 and 10. Therefore, we do not

think it would have been difficult to employ language in the claims precisely limiting them to

that scope.").

        Appellant further argues "[a] reading of this phrase under the conventions of the English

language results in the clear interpretation that the 'business entity definition' is what comprises

the 'plurality of information elements.' (Claim 17)." 2010 Brief at p. 19. The Examiner

respectfully disagrees.

        Appellant basically argues that because "comprising a plurality of information elements"

directly follows the "business entity definition," then the "'business entity definition' is what

comprises the 'plurality of information elements.'" Appellant's logic is flawed and, when

adopted to interpret the entire claim 17 as a whole, leads to other conclusions of indefiniteness.

In other words, if we applied this logic to every element of claim 17, then claim 17 would be

indefinite for other reasons.

        For example, if we applied Appellant's logic to the phrase "receiving a request in a

processor associated with said registry from a user to access a business entity definition

comprising a plurality of information elements," then the "from a user" would have to be

referring to the "said registry" and <u>not</u> the "receiving a request." Moreover, the "to access a

business entity definition" must refer to the claimed "a user" and <u>not</u> to the "receiving a request."

Therefore, under Appellant's own logic, claims 17-30 would be further indefinite because "said registry from a user" lacks antecedent basis in the claim, since the previously recited "registry" is <u>not</u> "from a user." Likewise, according to Appellant's own logic, claims 17-30 are further indefinite because one would not understand how the "a user" alone is "to access a business entity definition," since under Appellant's own interpretation the "business entity definition" is a data structure,[5] and one of ordinary skill in the art knows that a data structure cannot be accessed by a user alone (*e.g.*, the user needs a computer or processor).

The Examiner finds that other limitations would be indefinite if Appellant's logic were adopted as sound reasoning. For example, claim 17 also recites "obtaining the identity of the user from data associated with the request with said processor." Under one interpretation, the "with said processor" could refer to the "obtaining the identity of the user." Under Appellant's logic, the "with said processor" has to refer to the "the request." Under this interpretation claim 17 would be indefinite because the "the request with said processor" does not have proper antecedent basis in the claim and the scope of the "the request with said processor" cannot be reasonably determined.

In light of the above discussion, Appellant is respectfully requested (in a reply brief or other subsequent response) to answer the following: 1) what claim element does Appellant believe the "from a user" is in reference to?, 2) what claim element does Appellant believe the "to access a business entity definition" is in reference to?, and 3) what claim element does Appellant believe the "with said processor" is in reference to?

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[5] See 2010 Brief at p. 22, paragraph beginning with "The specification further makes it clear...."

C. *The Phrase "business entity definition," Among Others, is Indefinite*

Appellant argues:

> With respect to the Examiner's failure to find a lexicographic definition of the term "business entity definition" in the specification, the M.P.E.P. is quite clear that "a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible." M.P.E.P. § 2173.02 (citing to *Bancorp Svcs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004)).

2010 Brief at p. 21.

The Examiner agrees. However, it should be noted that the quote above (from MPEP §

2173.02) is in conclusion to the well-established notion that the claims "serve[] the notice

function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to

what constitutes infringement." Prior to this quote, it is established that "[t]he requirement to

'distinctly' claim means that <u>the claim must have a meaning discernible to one of ordinary skill

in the art</u> when construed according to correct principles...." *Metabolite Labs., Inc. v. Lab. Corp.

of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004) (emphasis

added). Therefore, the MPEP makes clear that its use of "Accordingly, a claim term that is not

used or defined in the specification is not indefinite if the meaning of the claim term is

discernible" is referring to whether the meaning of the claim term is discernible *from the claim

itself*.

Moreover, Appellant argues:

> The Examiner's requirement that each claim term be either specifically defined in the specification or well-known in the art creates a false dichotomy which precludes the notion that a claim's term can be discernible from how it is used in the specification in spite of the lack of a formal definition. *See id.*

2010 Brief at p. 21.

The Examiner respectfully disagrees.

Appellant's alleged "notion that a claim's term can be discernible from how it is used in the specification in spite of the lack of a formal definition" is misguided. As discussed above, MPEP § 2173.02 relies on the notion that the *claims* "serve[] the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement," and concludes that if a the meaning of a claim term (not used or defined in the specification) is discernable from the claim itself, then the term is not indefinite. This does not support Appellant's conclusion that "a claim's term can be discernible from how it is used in the specification in spite of the lack of a formal definition."

Additionally, the "requirement that each claim term be either specifically defined in the specification or well-known in the art" is well supported by controlling case law on this topic.

First, during patent examination, the pending claims (and their terms) must be given their broadest reasonable interpretation. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation in light of the specification.). This means that the words of the claim must be given their *plain meaning* unless the plain meaning is inconsistent

with the specification. *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69

USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and

unquestionable, absent any indication that their use in a particular context changes their meaning,

are construed to mean exactly what they say.).

 Furthermore, the Federal Circuit has also held that "the ordinary and customary meaning

of a claim term is the meaning that the term would have to a person of ordinary skill in the art in

question at the time of the invention, *i.e.*, as of the effective filing date of the patent application."

Phillips v. AWH Corp., 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (*en banc*).

 Moreover, the broadest reasonable interpretation of the claims must also be consistent

with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353,

1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board's construction of the claim limitation

"restore hair growth" as requiring the hair to be returned to its original state was held to be an

incorrect interpretation of the limitation. The court held that, consistent with applicant's

disclosure and the disclosure of three patents from analogous arts using the same phrase to

require only some increase in hair growth, one of ordinary skill would construe "restore hair

growth" to mean that the claimed method increases the amount of hair grown on the scalp, but

does not necessarily produce a full head of hair.).

 Therefore, the broadest reasonable interpretation standard unquestionably supports that

one possible construction of a claim term be the construction known to one of ordinary skill in

the art.

 Second, the exception to giving a claim term the broadest reasonable interpretation is

clear – when an applicant is his or her own lexicographer. In other words, minus the use of

§112, ¶6 (which is clearly not used in this application), only a lexicographic definition from applicant's specification trumps the broadest reasonable interpretation. This is reflected in the Federal Circuit's decision that where no explicit definition for a term is given in the specification, this term should be given its ordinary meaning and broadest reasonable interpretation. *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003) (where no explicit definition for the term "electronic multi-function card" was given in the specification, this term should be given its ordinary meaning and broadest reasonable interpretation.). Additionally, for applicant to be his or her own lexicographer, he or she must provide appropriate notice to the public that a term or phrase has been redefined. See, *e.g.*, *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) ("While we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning," in such a situation the written description must clearly redefine a claim term "so as to put a reasonable competitor or one reasonably skilled in the art on notice that the patentee intended to so redefine that claim term.").

Therefore, one of the following must be true: 1) a claim term is given the broadest reasonable interpretation, and hence it is given the construction known to one of ordinary skill in the art (*i.e.*, the term is well-known), or 2) a claim term is redefined by applicant (*i.e.*, it is lexicographically defined). Accordingly, there is no "false dichotomy" imposed by this well accepted doctrine, as alleged by Appellant above.

Applying this to Appellant's application, Appellant does not dispute that the phrase "business entity definition" is not lexicographically defined. Therefore, it must be known to one

of ordinary skill in the art. The Examiner has found that there is insufficient evidence of record to show that the phrase "business entity definition" is well-known in the art, and therefore the phrase "business entity definition" is indefinite.

Additionally, Appellant argues "Appellant's Declaration of October 5, 2010 provides multiple documents known in the art prior to the filing date of the present application." 2010 Brief at p. 22.

This argument is not persuasive. First, the declarations are not being considered in this appeal. Second, even if they were, none of the provided documents use the phrase "business entity definition."

This section also applies to Appellant's arguments on pp. 25-33 regarding other indefinite phrases. These arguments are rebutted in the same manner as shown above, and for brevity have not been individually addressed. The following phrases are not lexicographically defined and not known to one of ordinary skill in this art. Therefore, the following phrases are indefinite: "registry of business entity definitions," "business service entity information element," "binding template information element," "technical model information element," and "business entity information element."

IV. *Arguments Regarding 35 U.S.C. §§ 102/103*

A. *Kramer Anticipates Independent Claims*

Appellant argues that the phrase "business entity definition" must be given its plain

meaning. 2010 Brief at pp. 34-35.

The Examiner agrees. In other words, as discussed at length above, the phrase "business

entity definition" must be given the meaning known to one of ordinary skill in this art. This

meaning is unknown. There is insufficient evidence of record to show that the exact phrase

"business entity definition" has a particular meaning to one of ordinary skill in the art.

Additionally, Appellant argues:

> The plain meaning of the term "business entity definition" implies that
> data structure that defines a specific business-related entity. Additionally, the
> specification uses the term "business entity definition" to refer to an organization
> of data that "provides details of services provided.., by a business" and
> "descriptive information.., of the business." (Appellant's specification, p. 5 line
> 40 to p. 6 line 9). Thus, from the plain language of the term "business entity
> definition" and the fact that the specification only uses this term to refer to data
> defining a specific business entity, to anticipate the term "business entity
> definition" the data object of Kramer must at least be associated with and define a
> business entity. Kramer does not teach or suggest anywhere that each of its data
> objects is associated with a business entity. Accordingly, the data object of
> Kramer does not read on the "business entity definition" recited in claim 17, and
> Kramer does not teach or suggest "receiving a request from a user to access a
> business entity definition." (Claim 17).

2010 Brief at p. 35.

The Examiner respectfully disagrees. As shown above, the phrase "business entity

definition" is indefinite. As a matter of law, this phrase cannot be properly construed.

Moreover, the description of a single embodiment in the specification does not require

the claims to be construed as being limited to that embodiment. See *Liebel-Flarsheim Co. v.*

Medrad Inc., 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)(discussing recent

cases wherein the court expressly rejected the contention that if a patent describes only a single

embodiment, the claims of the patent must be construed as being limited to that embodiment).

Furthermore, the Federal Circuit has noted the inherent tension as to whether a statement

is a clear lexicographic definition or a description of a preferred embodiment. *E-Pass Techs.,*

Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003)

("Interpretation of descriptive statements in a patent's written description is a difficult task, as an

inherent tension exists as to whether a statement is a clear lexicographic definition or a

description of a preferred embodiment. The problem is to interpret claims in view of the

specification' without unnecessarily importing limitations from the specification into the

claims.").

In this application, it is clear there is no lexicographic definition of the phrase "business

entity definition," which is made clear by Appellant's 2010 Brief, and therefore the tension noted

above does not exist. Appellant is clearly citing to what they believe is a preferred embodiment,

which can only incorrectly be imported into the claims as a limiting element. *Id.*

Therefore, the Examiner need not construe the "business entity definition" in the same

manner as described by Appellant using limitations imported from the specification.

Accordingly, the Examiner disagrees that "to anticipate the term 'business entity definition' the

data object of Kramer must at least be associated with and define a business entity."

Rather, because the phrase "business entity definition" is indefinite, because the phrase "business entity definition" is not lexicographically defined, because the phrase is not defined by the claims themselves, because the phrase is not known to one of ordinary skill in the art, and because the Examiner is not required to import any limiting meaning from the specification, the Examiner's best guess as to the meaning of the "business entity definition" is that it is a data object. Therefore, the object of Kramer reads on the "business entity definition."

Additionally, Appellant argues "the Examiner has still failed to demonstrate any teaching in Kramer of a business entity definition 'comprising a plurality of information elements.' (Claim 17). Indeed, Kramer does not teach or suggest such 'a business entity definition comprising a plurality of information elements' anywhere." 2010 Brief at p. 36.

The Examiner respectfully disagrees. As shown above, the phrase "comprising a plurality of information elements" is indefinite because one cannot determine to which claim element it refers. As a matter of law, this phrase cannot be properly construed.

However, in the spirit of compact prosecution, the Examiner's best guess as to the meaning of "comprising a plurality of information elements" is that it refers to the claimed "processor." Therefore, Kramer's identifiers (c. 4, ll. 66-68) read on the "plurality of information elements" because they are comprised within the processor (*i.e.*, computer) of Kramer.

The remaining arguments of the 2010 Brief have the presumption that claims 17-30 satisfy the requirement of §112, ¶2. Under this presumption, Appellant's further arguments

require the narrow interpretation adopted by Appellant. Even though Appellant may have

support for such a narrow interpretation in the original specification, the Examiner's

interpretation is also reasonable. Therefore, these arguments are only relevant when adopting the

Appellant's narrow interpretation. Because the Examiner does not adopt such a narrow

interpretation, these arguments are not persuasive. As noted above, when a claim supports

multiple interpretations, and Appellant's desired interpretation is supported by the specification,

Appellant should amend the claim to precisely limit the claim to Appellant's desired

interpretation. See *In re Wiggins*, 488 F.2d 538, 179 USPQ 421, 424 (CCPA 1973) (emphasis in

original)(affirming 112, ¶2 rejection) ("[T]he examiner, in his answer, indicated that appellants

had support in the specification for a claim of the same scope that appellants would now have us

give claims 1 and 10. Therefore, we do not think it would have been difficult to employ language

in the claims precisely limiting them to that scope.").

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Examiner, Art Unit 3621
20 May 2011

/ANDREW J. FISCHER/
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